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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/476,662 06/07/95 KATZ R 6646-101NF

EXAMINER

BROWN, T

ART UNIT

PAPER NUMBER

2601

12

DATE MAILED:

11/26/96

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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 5/15, 9/12 & 10/22/96

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.**

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 29-35, 37-73, 75-144 and 146-178 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 29-35, 37-39, 50, 55-73, 75-97, 100-118, 125-137, 149-156, 159-173, 175 & 176 is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on 5-15-96 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 11

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

1. This action is responsive to the amendment received May 15, 1996 (Paper No. 7, "#7" hereinafter), which was held informal (in Office Paper No. 8); a further amendment received September 12, 1996 (Paper No. 9, "#9" hereinafter) submitted to correct the informalities in #7); and the supplemental amendment received October 22, 1996 (Paper No. 10, "#10" hereinafter).

For the record, the examiner notes that applicant's statement in #9, at page 8, first full paragraph, that "Claim 159 recites the combination of claim 37 (allowed) with further limitations...", etc., is not accurate: claim 37 included at least a limitation of "calling order of sequence" (line 25 thereof) that is not found in claim 159. However, claim 159 nevertheless is accepted as unobvious over the prior art herein for other reasons as should be apparent below, so the mischaracterization should be harmless.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 51-54, 98, 99, 119-124, 138-144, 146-148, 157, 158, 174, 177 and 178 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 51, lines 3-4, "said caller" lacks antecedent basis, and plural callers having been recited in the parent claim.

In claims 52 and 53, "said other data" is found to lack antecedence.

In claim 98, "said caller data signals compare a plurality of data elements" (emphasis added) is not understood: how can caller data signals compare anything?

In claim 119, line 31, "said communication facility" lacks antecedent basis.

With respect to claim 138, the examiner asks for clarification of support in applicant's disclosure of one called number identifying a plurality of operating formats, as the claim would require, as amended.

Art Unit: 2601

In claim 141, "said analysis structure" (lines 22-23) lacks antecedence. That structure is subsequently recited (in line 28), but its absence prior to the lines 22-23 reference renders the claim confusing and unclear.

In claim 157, lines 1-2, "said receiving step" lacks clear antecedence, there being two receiving steps in parent claim 151.

The limitations of dependent claim 174 are identical to those of claim 166, which depends from the same parent. The two duplicate claims obviously cannot co-exist.

4. The following informalities in the claims are noted, and appropriate correction thereof are required.

Claim 119 needs ---and--- after the semicolon in line 29.

In line 2 of claim 130 and line 3 of claim 131, "comprises" obviously should be instead ~~comprise~~---, to agree with the preceding subject "signals".

In claim 137, line 2, "are" should be instead ---is---, since "data" is a collective noun.

In claim 151, line 46, "is" should be instead ---being---, for clarity.

5. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. *At least* claims 40 and 41 (and the dependent claims 42-49) are rejected under the judicially created doctrine of double patenting over claims 1, 8, 11, 12, 14, et al. of U. S. Patent No. 4,845,739 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the "isolate a subset of callers" feature in the obviously similar combinations of claims 29, 40 and 41, as compared to that feature in the related combinations of various claims of the patent as noted above.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

In #7, at page 44, second full paragraph, last sentence, applicant stated,

"In the event the Examiner requires [a terminal disclaimer] for the other claims, it is requested that he apprise the undersigned either by telephone or in a subsequent communication."

The examiner thought he had made his view with respect to obviousness-type double patenting with respect to many of the claims in the present case apparent in #5, Section 9 thereof, but at any rate, *this* statement should be sufficient to apprise applicant of the need to file a terminal disclaimer, which must be filed and accepted before this case can be passed to issue.

7. Claims 29-35, 37-39, 50, 55-73, 75-97, 100-118, 125-137, 149-156, 159-173, 175 and 176 are found allowable for the reasons advanced by applicants. With respect to the previous issue regarding the "consumable participation key, particularly as defined in claim 159, the examiner accepts applicant's argument with respect thereto in #7, at pages 45-47. Of course, as indicated

Serial Number: 08/476,662

-5-

Art Unit: 2601

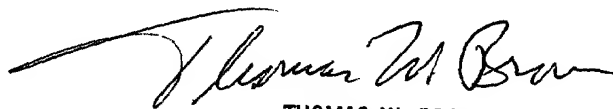
above, certain of these claims would be considered rejectable for obviousness-type double patenting unless applicant submits an acceptable terminal disclaimer, as stated. In view of the *In re Schneller* decision and the large number of claims in this case, it should not be necessary for the examiner to expend very substantial amounts of effort and time to formally present the comparisons and arguments to provide formal justifications for the rejection.

8. The claims rejected above under 35 USC §112, second paragraph (*except* for claim 174, which is an obvious duplicate) also would be considered allowable over the prior art of record if acceptably amended to avoid that rejection.

9. The Information Disclosure Statement filed October 22, 1996 (Paper No. 11) has been considered. Those references of course have been considered by the examiner during the prosecutions in which they were involved, and are considered also with respect to the present claims, and have not been found to render these claims obvious.

10. Any inquiry concerning this communication or earlier ones from the examiner should be directed to Thomas W. Brown whose telephone number is (703)305-4733. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-4750.

TWBrown
November 25, 1996



THOMAS W. BROWN
PRIMARY EXAMINER
GROUP 2601